

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-28 are now present in this application. Claims 1, 8, 15, 19, 24, 25 and 26 are independent. Claims 27 and 28 are added. Support for new claims 27 and 28 is found throughout Applicant's originally filed disclosure. Amendments have been made to claims 5, 8 and 19. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Acknowledgement

Applicant thanks the Examiner for correctly acknowledging Applicant's claim for foreign priority under 35 U.S.C. §119.

Claim Rejection under 35 U.S.C. §112, Second Paragraph

Claim 19 stands rejected under 35 U.S.C. §112, second paragraph, asserting that it is unclear to which determining step the limitation is directed. Applicant has amended claim 19 to recite "switching . . . on the basis of the results of at least one of the determining steps." Support for this is found, for example, in Fig. 6, which shows that switching is based on the basis of one or more previously performed steps, including steps S63 and S64, which are

determining steps. Reconsideration and withdrawal of this objection are respectfully requested.

Premature Final Rejection

Applicant respectfully submits that the last Office Action should not have been made a final Office Action. The basis of the rejection of claim 19 under 35 U.S.C. §112, second paragraph was present in originally filed claim 19. In the Amendment filed on July 9, 2004, the claim was amended to change “the determination” (singular number) to -- the determining step -- (singular number). Before the Amendment, claim 9 recited a single determination and after amendment, claim 19 recited a single determining step.

In other words, the amendment of claim 19 did not necessitate the rejection of claim 19. The very same rejection could have been made in the previous Office Action but was not made.

Under these circumstances, i.e., where Applicant’s amendment of claim 19 did not necessitate the new rejection of claim 19 under 35 U.S.C. §112, second paragraph, it was not proper to make the last Office Action a final Office Action.

Additionally, the rejections of claims 1, 3, 4, 8-11, 15, 19-21 rely on a different portion of Easterly than in the previous office Action, and Applicant’s amendments did not necessitate this change in the ground of rejection.

Accordingly, reconsideration and withdrawal of the finality of the last Office Action is respectfully requested.

Claim Objections

Claims 5 and 8 stand objected to. This objection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language lacks antecedent basis and a claim designator is incorrect.

In order to overcome this objection, Applicant has amended claims 5 and 8 to correct each of the deficiencies specifically pointed out by the Examiner. Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Reply to Examiner's Response to Applicant's Arguments

Starting on page 3 of the final Office Action, the Examiner indicates that Easterly discloses varying an aperture in response to an illumination condition, referencing col. 4, lines 52-59, and concludes that Easterly teaches switching a photographing mode of a camera because the aperture shifts from one aperture setting to another, i.e., one functioning arrangement to another. In this regard,

the Examiner defines “switch” as a shift from one to another, and defines “mode” as “a particular functioning arrangement or condition.”

Applicant respectfully disagrees with the Examiner’s position.

A “mode” is conventionally defined as a method of operation, and aperture control of a camera is a known method of operation of a camera. Another mode of camera operation is shutter control mode.

Aperture control is a well-recognized camera mode, which operates by varying the amount of light incident on the camera sensor. Simply changing the aperture is not switching the aperture camera mode. It is merely using the aperture mode of operation of the camera.

Moreover, with respect to this application, Applicant expressly defines the meaning of switching the photographing mode of the camera as photographing the scene by using an OLPF in the lens unit or without using the OLPF. See Applicant’s originally filed specification, page 8, lines 16-18.

As pointed out in Irdeto Access Inc. v. Echostar Satellite Corp., 72 USPQ2d 1678 (Fed. Cir. 2004) claim construction analysis begins with the intrinsic evidence. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 [39 USPQ2d 1573] (Fed. Cir. 1996). It is well-established that the patentee can act as his own lexicographer, so long as he clearly states any special definitions of the claim terms in the patent specification or file history. *Id.* Even when guidance is not provided in explicit definitional format, “the specification may define claim terms ‘by implication’ such that the meaning may be ‘found in or ascertained by a reading of the patent documents.’ ” Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc., 262 F.3d 1258, 1268 [59 USPQ2d 1865] (Fed. Cir. 2001) (quoting *Vitronics*, 90 F.3d at 1582, 1584 n.6). Moreover, if a disputed term has “no previous meaning to those of ordinary skill in the prior art[,] its meaning, then, must be found [elsewhere] in the patent.” J.T. Eaton & Co. v. Atl. Paste & Glue Co., 106 F.3d 1563, 1570 [41 USPQ2d 1641] (Fed. Cir. 1997).

In other words, Applicant has defined “switching the photographing mode of the camera” as “photographing the scene by using an OLPF in the lens unit or without using the OLPF,” where OLPF is defined as “optical low pass filter” (specification, page 2, lines 6-7).

In view of the case law cited above, it is clear that Applicant’s claims have to be interpreted consistently with Applicant’s specific definition of switching the

photographic mode of the camera, which is quoted above, and found in Applicant's specification as originally filed.

Accordingly, the Examiner's interpretation of Easterly is improper, in general, and is also improper with respect to this Application in which Applicant clearly is acting as its own lexicographer. Thus, the rejection of any claims based on Easterly is improper and should be withdrawn.

Starting on page 4, the outstanding Office Action argues that Beis detects the signal level of each cell "since pixel data is output row by row and column by column." While that may be true, for sake of argument, Beis certainly does not switch the photographing mode of the camera on the basis of determining whether the detected illumination levels of each cell region (of the plurality of cell regions) is higher than a previously determined standard illumination level. Beis clearly does not determine whether the detected illumination levels of each cell region are higher than a previously determined standard illumination level. All that Beis does in this regard is to determine the total intensity of the light beam 2. In this regard, Beis clearly discloses, in col. 4, lines 4-9, that the image selection and reflector control switch 8 operates in dependence on signal magnitude, i.e., in dependence on the intensity of the light beam 2.

Thus, Beis does not anticipate claims 8, 12 or 25.

Starting on page 5, the outstanding Office Action, the Office Action addresses the motivation to combine Bias in view of Easterly. In this regard, the

Office Action states that "Beis teaches alternative embodiments of the twilight switch, including the use of 'the magnitudes of the electrical output signals or image signals.'"

Applicant respectfully disagrees and respectfully submits that Beis actually discloses using magnitudes of electrical output signals or image signals as alternatives to use of a light sensitive switch. Beis only discloses that a twilight switch is one type of light sensitive switch, and clearly discloses using magnitudes of electrical output signals or image signals as alternatives to light sensitive switches. Beis does not disclose alternative types of twilight switches.

The Office Action then speculates that detecting the illumination level according to the statistical method of Easterly would be clearly advantageous in Bias because it would result in a more robust analysis. No objective evidence is presented to support this speculation, as required by existing case law, including In re Dembiczak and In re Lee, cited below.

The Office Action then tries to demonstrate that Easterly is reasonably pertinent to the particular problem with which Beis is concerned. In an attempt to do this, the Office Action goes to the most generic level possible, e.g., by stating that both references address analogous problems of producing an optimal exposure.

Applicant's response to this is that there are hundreds or thousands of U.S Patents that address problems of producing an optimal exposure, and this is not a

detailed enough reason to motivate one of ordinary skill in the art to redesign Beis to replace Beis' working system to incorporate a complicated film-to-video transfer system's brightness control system just to make Beis' system, that has not been shown to be in need of being made more robust, more robust.

The Office Action then addresses how Easterly operates and equates changing a lens aperture as switching to a low light intensity mode. However, as noted above, Applicant is his own lexicographer and Applicant has clearly defined what switching the photographing mode of a camera means. The Office Action's definition does not match Applicant's.

Accordingly, Applicant respectfully submits that all of the Examiner's rebuttal arguments, which Applicant appreciates receiving, have been addressed on their merits.

Reply to Remarks in the Advisory Action

Applicant traverses the assertion that the final Office Action was not a premature final rejection. Nevertheless, to expedite proceedings, Applicants are filing a Request for Continued Examination on even date herewith.

Applicant has added claims 27 and 28 to address the assertion that the use of an OLPF or non-use of an OLPF is not found in the claims. Although these features are not necessary for patentability, they are patentable features of the claimed invention.

Rejection Under 35 U.S.C. §102

Claims 1, 3, 4, 8-11, 15, 19-21 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,038,216 to Easterly et al. (hereinafter, "Easterly"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Independent claims 1, 8, 15, 19 and 25 are not anticipated by Easterly. Claim 1 recites a number of steps including switching a photographing mode of a camera. Easterly does not perform the claimed invention. Easterly is directed to obtaining automatic color balancing of color photographic images for subsequent display on a color monitor in a film-to-video transfer system. See the preamble of claim 6 of Easterly, for example, and col. 4, lines 10-64, for example. Easterly does not disclose switching a photographic mode of a camera in any manner whatsoever.

The Office Action alleges that the switching of a photographic mode based on the comparison of illumination levels is disclosed in col. 18, line 62 to col. 19, line 11. (Applicant notes that this is a different basis for the rejection than in the previous office Action, which relied on col. 4, lines 52-59 and col. 33, lines 24-28 for such a teaching, and thus, the last Office Action was improperly and prematurely made a final Office Action.)

However, col. 18, line 62 to col. 19, line 1 of Easterly merely discloses details of an apparatus, including a variable aperture that automatically controls brightness of an optical image that is translated into digital samples.

Also, in col. 33, lines 24-28, which are part of Easterly's claim 1, the automatic brightness control, including means to vary an aperture, is claimed. There is no disclosure of switching the mode of a camera, here, either.

However, there is no disclosure in Easterly of switching the mode of a camera as defined by Applicant. As noted above, varying the aperture is not changing the photographic mode. It is merely operating within a particular photographic mode, i.e., an aperture control mode.

Additionally, Applicant's originally filed specification, page 8, lines 16-18, clearly states “[H]ere, the meaning of switching the photographing mode of the camera is photographing the scene by using an OLPF in the lens unit or without using the OLPF. The lens unit is a lens assembly or lens module and includes a lens group.”

In other words, Applicant has defined “switching the photographing mode of the camera” as “photographing the scene by using an OLPF in the lens unit or without using the OLPF,” where OLPF is defined as “optical low pass filter” (specification, page 2, lines 6-7).

In view of the case law cited above, it is clear that Applicant's claims have to be interpreted consistently with Applicant's specific definition of switching the

photographic mode of the camera, which is quoted above, and found in Applicant's specification as originally filed.

Accordingly, the Examiner's interpretation of Easterly is improper and this rejection of claims 1, 3, 4, 8-11, 15, 19-21 and 25 as anticipated by Easterly is improper and should be withdrawn.

Furthermore, because claims 3 and 4 depend from claim 1, claims 9-11 depend from claim 8, and claims 20-21 depend from claim 19, dependent claims 3, 4, 9-11, 20 and 21 are not anticipated by Easterly.

Reconsideration and withdrawal of this rejection of claims 1, 3, 4, 8-11, 15 19-21 and 25 is respectfully requested.

Claims 8, 12 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,172,220 to Beis. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Beis does not anticipate claims 8, 12 and 25. Claims 8, 12 and 25 recite a combination of features, including "switching the photographing mode of the camera on the basis of determining whether the detected illumination levels of each cell region is higher than a previously determined standard illumination level."

Beis does not switch the photographing mode of the camera on the basis of determining whether the detected illumination levels of each cell region (of the plurality of cell regions) are higher than a previously determined standard illumination level.

Beis does not even determine whether the detected illumination levels of each cell region are higher than a previously determined standard illumination level. All that Beis does in this regard is to determine the total intensity of the light beam 2. In this regard, Beis clearly discloses, in col. 4, lines 4-9, that the image selection and reflector control switch 8 operates in dependence on signal magnitude, i.e., in dependence on the intensity of the light beam 2.

Accordingly, Beis does not anticipate claims 8, 12 and 25.

Accordingly, this rejection is improper. Reconsideration and withdrawal of this rejection of claims 8, 12 and 25 is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1, 5-7, 13-19, 22-24 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 5,038,216 to Easterly. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact

that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Eritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made.

However, these inquiries are not found in this rejection.

Beis does not disclose the invention recited in independent claims 1 and 19 at least for the reasons stated above. Easterly does not disclose the features recited in independent claims 1, 15, 19, 24 and 26, at least for the reasons stated above.

Applicant respectfully submits that the discussion of Beis on page 9 of the rejection is incomplete and misleading. The “twilight switch” of Beis is discussed above, and is used by Beis to decide when to switch from a daylight mode to a

nighttime mode. Beis discloses an embodiment in which he uses a single detector with different sensing elements for black and white and different sensing elements for color. No specific detector patterns are disclosed. Beis discloses "the magnitudes of the electrical output signals or image signals can be used" as the twilight switch. No details of how the image signals are used are presented.

Moreover, as discussed above, Applicant respectfully submits that Beis only discloses using magnitudes of electrical output signals or image signals as alternatives to use of a light sensitive switch. Beis only discloses that a twilight switch is one type of light sensitive switch, and clearly discloses using magnitudes of electrical output signals or image signals as alternatives to light sensitive switches. Beis does not disclose alternative types of twilight switches. Beis switches from a daytime mode to a nighttime mode based on ". . . a light sensitive switch, e.g., a twilight switch, which is activated when the intensity of the incoming light reaches a threshold value. Alternatively, the magnitudes of the electrical signals or image signals can be used." – see col. 2, lines 30-36.

Additionally, Beis does not disclose or suggest a combination of features, including detecting an illumination level of each cell region; and switching the photographing mode of the camera on the basis of determining whether the detected illumination level of each cell region is higher than a previously determined standard illumination level, as recited.

The Office Action then turns to Easterly, which has nothing to do with switching between a daytime photographing mode and a nighttime mode of operation of a camera, but is directed to a device that automatically balances the colors in an image being transferred from film to video from a photographic medium to an electronic medium.

The Office Action alleges that Easterly teaches that a camera may switch to a low light intensity mode when the number of cell regions having a lower illumination level than the standard illumination level is greater than a certain percentage of the total number of cell regions, referencing col. 18, lines 64-70 and col. 33, lines 31-34. Applicant disagrees.

Col. 18, lines 64-70 of Easterly concerns scanning a transparency and providing maximum pixel values. Col. 33, lines 31-34 of Easterly recite a means to open an aperture through which an image is transmitted for digitization. The Office Action speculates that “providing in Beis a statistical method for considering the illumination of the plurality of cell regions” would make the determination to switch modes more robust by factoring in all available illumination information. However, the Examiner provides no objective evidence for this speculative general assertion.

Then, based on this speculative general statement, the Office Action concludes that it would be obvious to use the statistical method of Easterly to modify Beis in order to make the mode-switching decision accurately. Applicant respectfully submits that the Office Action fails to meet its burden of

demonstrating proper motivation for one of ordinary skill in the art to modify Beis as proposed.

In the first place, the Office Action does not address the fact that Beis and Easterly are concerned with distinctly different problems, and that they function differently. Beis discloses a surveillance camera with a fixed lens that has a simple twilight switch to switch between a daytime mode and a nighttime mode of operation. Beis has no disclosure of a need to modify its twilight switch. Beis also does not disclose (as admitted in the rejection) counting the number of cell regions having a lower illumination level than the standard illumination level and determining whether the counted number is greater than a certain percentage of the total number of cell regions.

In the second place, Easterly contains no disclosure of (1) a surveillance camera, (2) a daytime mode of operation and a nighttime mode of operation; or (3) a switch to switch between the daytime mode of operation and the nighttime mode of operation.

In the third place, the Office Action fails to provide objective evidence that one of ordinary skill in the art would desire to modify a surveillance camera like that of Beis with a film to video transfer system, especially a certain part of that system that has to do with properly balancing colors in an image being transferred from film to an electronic medium. Beis has no such feature or a need for such a feature.

The mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggested the desirability of the modification.

All that is presented in terms of motivation is the alleged desirability of providing a statistical method of Easterly's color balancing system to Beis. However, this statement is nothing more than a broad, conclusory speculative statement that, standing alone, is not evidence of motivation to modify Beis and provide Beis with such a system. See In re Dembiczak, cited above, in this regard.

Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). No such objective evidence is presented. All that is presented is a speculative generalized statement that does not constitute a clear particular motivation to combine such disparate references. Accordingly, the motivation for modifying Beis to include the claimed features must be based on speculation and/or impermissible hindsight.

The Office Action also tries to demonstrate that Easterly is reasonably pertinent to the particular problem with which Beis is concerned. In an attempt to do this, the Office Action goes to the most generic level possible, e.g., by stating

that both references address analogous problems of producing an optimal exposure.

As noted above, Applicant's response to this is that there are hundreds or thousands of U.S Patents that address problems of producing an optimal exposure, and this is not a detailed enough reason to motivate one of ordinary skill in the art to redesign Beis to replace Beis' working system to incorporate a complicated film-to-video transfer system's brightness control system just to make Beis' system, that has not been shown to be in need of being made more robust, more robust.

For at least the aforementioned reasons, the Office Action fails to make out a *prima facie* case of proper motivation to modify Beis in view of Easterly, as suggested, and thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 6, 7, 13-19, 22 and 23 is respectfully requested.

New Claims 27 and 28

Claims 27 and 28 recite the specific camera modes of photographing a scene with or without an OLPF, and are neither disclosed nor suggested by the applied art, at least for the reasons stated above regarding the rejections of record. Moreover, these claims clearly set forth what is meant by the terminology camera mode.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Pursuant to the provisions of 37 CFR 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in

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connection with the present application. The required fee of \$330.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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